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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,703	07/13/2001	Yoshiyuki Hirai	35.C15573	1348

5514 7590 11/29/2004

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EXAMINER	
POKRZYWA, JOSEPH R	
ART UNIT	**PAPER NUMBER**
2622	

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/903,703	HIRAI ET AL.	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/14/02 & 10/31/01*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statements submitted on 5/14/02 and 10/31/01 have been considered by the examiner (see attached PTO-1449's).

Response to Preliminary Amendment

3. Applicant's preliminary amendment was received on 11/16/01, and has been entered and made of record. Currently, **claims 1-22** are pending.

Drawings

4. The drawings received on 7/13/01 are acceptable by the examiner.

Claim Objections

5. **Claim 18** is objected to because of the following informalities:

in ***claim 18***, line 2, "plurality modes" should read "plurality <u>of</u> modes".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-4, 7-12, and 17-22** are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto *et al.* (U.S. Patent Number 5,392,132, cited in the Information Disclosure Statement dated 5/14/02)

Regarding ***claim 1***, Yamamoto discloses a communication system (see Fig. 2) having a scanner (handy scanner 1) and an image communication apparatus (host machine 2) communicating with the scanner (column 4, lines 28-54), comprising wireless communicating means for communicating between the image formation apparatus and the scanner via a wireless line (see Fig. 2, and column 4, line 41-column 6, line 53), image read completion detecting means for detecting that the scanner completes image read (step S1301 in Fig. 13, column 11, lines 7-67), and controlling means for releasing standby mode when the scanner completes image read (step S1202, whereby a "reception-ready signal" is transferred to the remote scanner after the reading and image transmission is complete, thereby releasing a standby mode, as seen in step S1206 of Fig. 13, and column 11, lines 39-67).

Regarding ***claim 2***, Yamamoto discloses the system discussed above in claim 1, and further teaches that the controlling means sends to the image communication apparatus a command to notify that the standby mode is released (step S1202, whereby a "reception-ready

signal" is transferred to the remote scanner, thereby releasing a standby mode, as seen in step S1206 of Fig. 13, and column 11, lines 39-67).

Regarding ***claim 3***, Yamamoto discloses the system according to claim 1, and further teaches of selecting means for selecting printing of the image read by the scanner (column 4, lines 33-63), request command sending means for sending a command to request start of transmission print data from the scanner to the image communication apparatus after the standby mode is released (step S1202, whereby a "reception-ready signal" is previously transferred to the remote scanner, thereby releasing a standby mode, as seen in step S1206 of Fig. 13, and column 11, lines 39-67), if printing is selected, and image data transmission starting means in which the scanner starts transmission of image data stored in a memory, when the scanner receives from the image communicating apparatus a command to permit start of transmission of print data (column 11, lines 39-67).

Regarding ***claim 4***, Yamamoto discloses the system according to claim 1, and further teaches of selecting means for selecting transmission of the image read by the scanner to a communication line connected to the image communication apparatus (column 4, lines 41-63, and column 11, lines 24-67), request command sending means for sending a command to request start of transmission of transmission data from the scanner to the image communication apparatus after the standby mode is released (step S1202, whereby a "reception-ready signal" is previously transferred to the remote scanner, thereby releasing a standby mode, as seen in step S1206 of Fig. 13, and column 11, lines 39-67), if transmission to the communication line is selected, and image data transmission starting means in which the scanner starts transmission of image data stored in a memory, when the scanner receives from the image communicating

apparatus a command to permit start of transmission of transmission data (column 11, lines 39-67).

Regarding ***claim 7***, Yamamoto discloses the system according to claim 1, and further teaches that the wireless communicating means establishes a wireless link through an initial connection procedure (column 11, line 14- column 13, line 61), opens the wireless link if the standby state is continued for a given time period after establishing the wireless link and performing predetermined communication between the image communication apparatus and the scanner (column 11, lines 55-67), and make transition to the state of carrying out the initial connection procedure at the time of establishing the wireless link again (column 11, lines 39-67).

Regarding ***claim 8***, Yamamoto discloses the system discussed above in claim 5, and further teaches that the scanner is a portable scanner (column 5, lines 13-49) that can be detached from and attached to the image communication apparatus (column 5, lines 26-49).

Regarding ***claim 9***, Yamamoto discloses a communication system (see Fig. 2) having a scanner (handy scanner 1) and an image communication apparatus (host machine 2) communicating with the scanner (column 4, lines 28-54), comprising wireless communicating means capable of performing wireless connection between the image communication apparatus and the scanner (see Fig. 2, and column 4, line 41-column 6, line 53), and having a plurality of modes (see Figs. 13-15), mode changing means for changing mode of the wireless communication means if the image read by the scanner is sent to the image communication apparatus depending on a predetermined operation of the scanner (see Figs. 14 and 15, column 12, line 11-column 13, line 61).

Regarding ***claim 10***, Yamamoto discloses the system according to claim 9, and further teaches that the mode changing means changes the mode in accordance with the predetermined operation and the mode of the wireless communicating means (see Figs. 13-15, and column 12, line 11-column 13, line 61).

Regarding ***claim 11***, Yamamoto discloses the system according to claim 9, and further teaches that the predetermined operation is an operation for outputting the image read by the scanner by the image communication apparatus (column 4, lines 48-63, and column 11, line 7-column 12, line 68).

Regarding ***claim 12***, Yamamoto discloses the system according to claim 11, and further teaches that the output include both of or any one of print output and output to the communication line connected to the image communication apparatus (see Fig. 2, and column 4, lines 48-63, and column 11, lines 15-67).

Regarding ***claim 17***, Yamamoto discloses the system according to claim 9, and further teaches that the wireless communicating means establishes a wireless link through an initial connection procedure (column 11, line 14- column 13, line 61), opens the wireless link if the standby state is continued for a given time period after establishing the wireless link and performing predetermined communication between the image communication apparatus and the scanner (column 11, lines 55-67), and make transition to the state of carrying out the initial connection procedure at the time of establishing the wireless link again (column 11, lines 39-67).

Regarding ***claim 18***, Yamamoto discloses a communication apparatus (host machine 2) connectable wirelessly to a scanner (handy scanner 1, see Fig. 2) having a plurality of modes associated with wireless communication (see Figs. 13-15), comprising detecting means for

detecting a predetermined operation (see Figs. 13-15, column 11, line 7-column 13, line 61), and mode changing means for changing the mode of the scanner if the image read by the scanner is sent to the image communication apparatus depending on detection by the detecting means (see Figs. 14 and 15, column 12, line 11-column 13, line 61).

Regarding ***claim 19***, Yamamoto discloses a communication apparatus (handy scanner 1, see Fig. 2) comprising determining means for determining existence/not existence of original for reading an image (step S1301 in Fig. 13, column 11, lines 7-67), and controlling means for performing control so that wireless communication with other apparatus is possible (see Figs. 13-15), based on the result of determination by the determining means (see Fig. 13, column 11, lines 7-67).

Regarding ***claim 20***, Yamamoto discloses a method for controlling a communication system (see Fig. 2) having a scanner (handy scanner 1) and an image communication apparatus (host machine 2) communicating with the scanner (column 4, lines 28-54), capable of performing wireless connection between the image communication apparatus and the scanner (see Fig. 2, and column 4, line 41-column 6, line 53), and having wireless communicating means having a plurality of modes (see Figs. 13-15), comprising changing mode of the wireless communication means if the image read by the scanner is sent to the image communication apparatus depending on a predetermined operation (see Figs. 14 and 15, column 12, line 11-column 13, line 61).

Regarding ***claim 21***, Yamamoto discloses a method for controlling a communication apparatus (host machine 2) connectable wirelessly to a scanner (handy scanner 1, see Fig. 2) having a plurality of modes associated with wireless communication (see Figs. 13-15),

comprising a detecting step of detecting a predetermined operation (see Figs. 13-15, column 11, line 7-column 13, line 61), and a mode changing step of changing the mode of the scanner if the image read by the scanner is sent to the image communication apparatus depending on detection in the detecting step (see Figs. 14 and 15, column 12, line 11-column 13, line 61).

Regarding ***claim 22***, Yamamoto discloses a method for controlling a communication apparatus (handy scanner 1, see Fig. 2) comprising a determining step of determining existence/not existence of original for reading an image (step S1301 in Fig. 13, column 11, lines 7-67), and a controlling step of performing control so that wireless communication with other apparatus is possible (see Figs. 13-15), based on the result of determination in the determining step (see Fig. 13, column 11, lines 7-67).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. **Claims 5, 6, and 13-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto *et al.* (U.S. Patent Number 5,392,132, cited in the Information Disclosure Statement dated 5/14/02) in view of Nevo *et al.* (U.S. Patent Number 6,600,726).

Regarding ***claims 5 and 15***, Yamamoto discloses the systems discussed above in claims 1 and 9, and further teaches that the wireless communicating means establishes a wireless link through an initial connection procedure (column 11, line 14- column 13, line 61), opens the

wireless link if the standby state is continued for a given time period after establishing the wireless link and performing predetermined communication between the image communication apparatus and the scanner (column 11, lines 55-67).

However, Yamamoto fails to expressly disclose of making a transition to a low power consumption connection state not requiring the initial connection procedure, at the time of establishing the wireless link again.

Nevo discloses a communication system (see Fig. 1) having a scanner and an image communication apparatus communicating with the scanner (column 3, line 28-column 4, line 55), comprising wireless communicating means for communicating between the image formation apparatus and the scanner via a wireless line (column 4, lines 36-55), and controlling means for releasing standby mode (column 5, lines 1-59). Further, Nevo teaches that the wireless communicating means establishes a wireless link through an initial connection procedure (column 4, line 46-column 5, line 49), opens the wireless link if the standby state is continued for a given time period after establishing the wireless link and performing predetermined communication between the image communication apparatus and the scanner (column 5, lines 1-59), and makes transition to a low power consumption connection state not requiring the initial connection procedure, at the time of establishing the wireless link again (column 5, line 9-column 6, line 53).

Yamamoto & Nevo are combinable because they are from the same field of endeavor, being systems that perform a wireless communication between a scanner and a host computer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include Nevo's teachings of transitioning to a low power connection state within the system of

Yamamoto. The suggestion/motivation for doing so would have been that Yamamoto's system would become more efficient and economical with the addition of Nevo's teachings, as read in column 1, lines 41-62, and column 5, lines 30-49, whereby transitioning to a no operation state would conserve power. Therefore, it would have been obvious to combine the teachings of Nevo with the system of Yamamoto to obtain the invention as specified in claims 5 and 15.

Regarding ***claims 6 and 16***, Yamamoto and Nevo disclose the systems discussed above in claims 5 and 15, and Nevo further teaches that if given time further passes after making transition to the low power consumption connection state, the wireless communicating means eliminates the low power consumption connection state to open the wireless connection (column 5, lines 40-49), and makes transition to the state of carrying out the initial connection procedure at the time of establishing the wireless link again (column 5, lines 40-59).

Yamamoto & Nevo are combinable because they are from the same field of endeavor, being systems that perform a wireless communication between a scanner and a host computer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include Nevo's teachings of transitioning to a low power connection state within the system of Yamamoto. The suggestion/motivation for doing so would have been that Yamamoto's system would become more efficient and economical with the addition of Nevo's teachings, as read in column 1, lines 41-62, and column 5, lines 30-49, whereby transitioning to a no operation state would conserve power. Therefore, it would have been obvious to combine the teachings of Nevo with the system of Yamamoto to obtain the invention as specified in claims 6 and 16.

Regarding ***claim 13***, Yamamoto discloses the system according to claim 9, but fails to expressly disclose if the mode changing means changes mode so that at least power consumption of the wireless communicating means is changed.

Nevo discloses a communication system (see Fig. 1) having a scanner and an image communication apparatus communicating with the scanner (column 3, line 28-column 4, line 55), comprising wireless communicating means for communicating between the image formation apparatus and the scanner via a wireless line (column 4, lines 36-55), and controlling means for releasing standby mode (column 5, lines 1-59). Further, Nevo teaches of a mode changing means changes mode so that at least power consumption of the wireless communicating means is changed (column 5, lines 30-59).

Yamamoto & Nevo are combinable because they are from the same field of endeavor, being systems that perform a wireless communication between a scanner and a host computer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include Nevo's teachings of transitioning to a low power connection state within the system of Yamamoto. The suggestion/motivation for doing so would have been that Yamamoto's system would become more efficient and economical with the addition of Nevo's teachings, as read in column 1, lines 41-62, and column 5, lines 30-49, whereby transitioning to a no operation state would conserve power. Therefore, it would have been obvious to combine the teachings of Nevo with the system of Yamamoto to obtain the invention as specified in claim 13.

Regarding ***claim 14***, Yamamoto discloses the system according to claim 11, but fails to expressly disclose if the wireless communicating means performs communication based on the Bluetooth specification.

Nevo discloses a communication system (see Fig. 1) having a scanner and an image communication apparatus communicating with the scanner (column 3, line 28-column 4, line 55), comprising wireless communicating means for communicating between the image formation apparatus and the scanner via a wireless line (column 4, lines 36-55), and controlling means for releasing standby mode (column 5, lines 1-59). Further, Nevo teaches that the wireless communicating means performs communication based on the Bluetooth specification (column 4, lines 36-55).

Yamamoto & Nevo are combinable because they are from the same field of endeavor, being systems that perform a wireless communication between a scanner and a host computer. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include Nevo's teachings of communicating using the Bluetooth specification within the system of Yamamoto. The suggestion/motivation for doing so would have been that Yamamoto's system would conform with well-known standards, as recognized by Nevo in column 4, lines 36-55, thus being usable to more users. Therefore, it would have been obvious to combine the teachings of Nevo with the system of Yamamoto to obtain the invention as specified in claim 14.

Citation of Pertinent Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Liebenow (U.S. Patent Number 6,459,896) discloses a low-battery indication system in a wireless network; and

Ogawa *et al.* (U.S. Patent Number 6,115,739) discloses a network scanning system.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp